

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KYEONG-TAEG YANG

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Appeal No. 2000-2291  
Application No. 08/777,721<sup>1</sup>

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HEARD: NOVEMBER 21, 2002

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Before LALL, GROSS, and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claim 1. Claims 6-20 have been allowed. The Examiner has objected to claims 2-5 and has indicated their allowability if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

We reverse.

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<sup>1</sup> Application for patent filed December 20, 1996, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of Korean Application 1995-53538, filed December 21, 1995.

BACKGROUND

Appellant's invention is directed to a wireless telephone set having a built-in facsimile and a cordless unit and to a method for informing a user of the status of the facsimile apparatus by an aural message. A voice mixer stores a plurality of messages which are processed and transmitted to the cordless unit according to specific codes indicating the status of the facsimile apparatus (specification, pages 4 & 5). As depicted in figures 3A and 3B, the method includes the steps of sensing and verifying whether a transmit or receive key is received, of sending the aural message to inform the user of the mode and the completion/failure of the facsimile transmission/reception (specification, page 8).

Independent claim 1 is reproduced below:

1. A method for sending an aural message to a user of a cordless handset of a wireless telephone set having and<sup>2</sup> a base unit incorporating a facsimile apparatus, said method comprising the steps of:

determining an operational state of said facsimile apparatus; and

transmitting an aural message, stored in a voice mixer and corresponding to the operational state of said facsimile apparatus, to said cordless handset.

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<sup>2</sup> We recommend that Appellant and the Examiner consider amending the claim to clarify the structure included in the telephone set other than the base unit.

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The Examiner relies on the following references in rejecting the claims:

Hayashi	5,479,485	Dec. 26, 1995 (filed Apr. 15, 1991)
Van Buskirk	5,684,260	Nov. 4, 1997 (filed Sep. 9, 1994)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of Van Buskirk.

Rather than reiterate the viewpoints of the Examiner and Appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 18, mailed October 14, 1999) for the Examiner's reasoning, the appeal brief (Paper No. 17, filed September 13, 1999) and the reply brief (Paper No. 20, filed December 14, 1999) for Appellant's arguments thereagainst.

#### OPINION

Appellant argues that the purpose of generating audio signals, sounds and voices in Van Buskirk "is not equivalent to the purpose of providing an audio message indicative of the operational state of the facsimile apparatus" (brief, page 7). Additionally, Appellant points out that Hayashi's step a1 (Figure 5) merely determines whether a reception signal requests facsimile or telephone communication and switches the connection

to the corresponding device (brief, page 8 and reply brief, page 9). Finally, Appellant argues that even if determining the operational state is whether a reception signal is detected or not, the user of the cordless handset would not be informed by an aural message stored in the voice mixer that the facsimile apparatus is in reception mode (brief, page 9 and reply brief, page 11). In that regard, Appellant asserts that the handset is informed only when a ringing burst indicates the state of not-receiving wherein the burst is neither an aural message nor stored in a voice mixer (reply brief, pages 10 & 11).

In response to Appellant's arguments, the Examiner asserts that incorporating the step of transmitting an aural message stored in a voice mixer of Van Buskirk in Hayashi's method of sending a message to a user of a cordless handset would have been obvious (answer, page 4). The Examiner further argues that Hayashi's step a1 (Figure 5) determines an operational state of the facsimile by determining whether the facsimile is receiving or not (answer, page 10).

The initial burden of establishing reasons for unpatentability rests on the Examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Where, as here, a conclusion of obviousness is premised upon a combination

of references, the Examiner must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. V. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996). However, "the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Upon a review of Hayashi, we find that the reference relates to a facsimile apparatus that incorporates a cordless telephone set. As depicted in Figures 4 and 5, after the CPU responds to the receipt of an incoming signal (step a1), a CNG facsimile request signal is transmitted from the caller (step a3) which causes the relay switch to connect the telephone line to the facsimile apparatus (col. 6, lines 20-33). If voice communication is requested by the caller, a ringing burst is generated (step a5) and emitted from the remote unit (col. 6, lines 34-41). Therefore, Hayashi does not send any signal to the cordless unit when a facsimile signal is received. In fact, the ringing burst is generated only when no facsimile reception signal is detected and the external line is to be transferred to

the telephone set instead of the facsimile apparatus (col. 6, lines 49-53).

Van Buskirk, as conceded by the Examiner and Appellant, relates to an apparatus for producing signals representative of complex time varying audio signals or musical waveforms by synthesizing musical sounds. As depicted in Figure 5, the voice synthesis function 504 generates one or more voices and receives the output from white noise generator 512. The outputs of the voice synthesis function are sent to voice mixer function 512 which generates the output process (col. 12, lines 1-14). However, our review of the reference reveals no teaching related to using the synthesized voice signals processed in the voice mixer as an aural message corresponding to the operational state of a facsimile apparatus, as recited in claim 1.

As the Federal Circuit states, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The court further reasons in Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286,

1293 (Fed. Cir. 2001) that for an invention to be obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

Based on these well-settled principles, we disagree with the Examiner that, because voice mixers are used in generating synthesized voice signals from complex time varying audio signals or music waveforms, one of ordinary skill in the art would have found it obvious to combine the voice synthesizer of Van Buskirk with the facsimile apparatus of Hayashi. Although, broadly speaking, Hayashi's step a3 determines whether the facsimile apparatus is receiving or not and could be interpreted as the claimed step of determining an operational state of the facsimile apparatus, Van Buskirk provides no teaching or suggestion for incorporating in a telephone-facsimile apparatus the synthesized voice function stored in a voice mixer. Van Buskirk, in fact, merely discloses a method for processing in a voice mixer the output signal from a voice synthesis function and it is the claimed invention that provides the details of how to transmit an aural message, stored in a voice mixer, corresponding to the operational state of the facsimile apparatus. Furthermore, we

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agree with Appellant that "the purpose of generating audio signals, musical sounds, tones or voices representative of complex time varying audio signals or musical waveforms" would not have taught or motivated one of ordinary skill in the art to transmit as aural message stored in a voice mixer in Hayashi's apparatus.

Based on our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions for implementing synthesized signals stored in the voice mixer of Van Buskirk as the aural message corresponding to the operational state of the facsimile apparatus of Hayashi, are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claim 1 over Hayashi and Van Buskirk.



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CONCLUSION

In view of the foregoing, the decision of the Examiner  
rejecting claim 1 under 35 U.S.C. § 103 is reversed.

REVERSED

PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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